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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,183	02/08/2001	Eric Ellington	OAA-145-A	6456

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CARRIER BLACKMAN AND ASSOCIATES
24101 NOVI ROAD
SUITE 100
NOVI, MI 48375

EXAMINER


FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/779,183	Applicant(s) ELLINGTON, ERIC	
	Examiner Bryan Fischmann	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14, 16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 16, 18, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 9, 11-14, 19, 20 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-07-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3618

Acknowledgements

1. The amendment and affidavit filed 07⁰⁷~~06~~-2004 have been entered.

DT
8-31-4

Claim Objections

2. Claims 11 and 12 are objected to due to the following:

Claims 11 and 12 are dependant upon claim 10, which has been canceled.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9, 11-14, 19, 20 and 23-25 are rejected under 35 USC 112 1st paragraph due to the following:

Claim 9 recites "An elevated deck snowboard... comprising...an elongated slide board...an elongated step board...wherein the spacing between the slide board and step board is greater than the combined thickness of the slide board and the step board".

This recitation is considered to lack adequate written description, as the above recitation is considered new matter.

Specifically, the originally filed disclosure dated 02-08-2001 does not appear to support the portion of the above recitation that recites "the spacing between the slide

Art Unit: 3618

board and step board is greater than the combined thickness of the slide board and the step board”.

No support can be found in the original specification or claims for the above recitation, regarding the distance between the slide and step board.

The originally filed drawings dated 02-08-2001 appear to be “inconsistent” regarding the above recitation concerning the distance between the two boards. While Figure 3 appears to show that the distance between the two boards is less than the combined thickness of the two boards, Figure 4 appears to show that the distance between the two boards is slightly greater than the thickness between the two boards. Due to this inconsistency, and the fact that drawing figures in patent applications are not required to be drawn to scale, the originally filed drawings are also considered to provide adequate written description that the space between the two boards is greater than the combined thickness of the two boards. Therefore, the above claim 9 recitation is considered new matter.

Per Section 2163.06 of the MPEP, new matter in the claims should be rejected under 35 USC 112 first paragraph, written description requirement.

Note that independent claims 19 and 25 contain a similar recitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

Art Unit: 3618

a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dykema, et al, US Patent 4,848,781.

Dykema teaches an elevated deck snowboard for sliding over snow, comprising:
an elongated slide board (16) having a slide surface on a lower surface thereof
and having a defined length;

an elongated step board (24) defining a deck on an upper surface thereof which
is capable of freely accommodating both feet of a user, said step board having
peripheral edges; and

a plurality of connecting members (Figure 6) non-integrally connecting the step
board to an upper surface of the slide board in spaced and substantially parallel
relationship (when the board is not in use), the connecting members being disposed
inwardly of the peripheral edges of the slide and step boards (see drawing figures);

where open spaces are defined between the peripheral edges of the boards (see
drawing figures).

Dykema fails to explicitly state that the connecting members space the step
board upwardly from the slide board by a distance which is greater than the combined
thickness of the two boards.

However, a close examination of Figures 6, 7 and 9 of Dykema appear to show
that the distance between the step and slide boards of Dykema is greater than the
combined thickness of the two boards.

Art Unit: 3618

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the distance between the slide and step boards of Dykema is greater than the combined thickness of the two boards.

See also the 112 1st paragraph rejection set forth in this Office Action.

Allowable Subject Matter

7. Claims 1-8, 16, 18, 21, 22 are allowed.

Examiner's Comments

8. The affidavit filed 07-06-2004 has overcome the 35 USC 185 rejection set forth in the last Office Action.

9. The Applicant's comments made in the amendment filed 07-06-2004 in traversing the 103 rejection of claim 25 set forth in the last Office Action are compelling. Therefore, the 103 rejection set forth in the last Office Action is withdrawn.

10. However, upon further review, the Examiner cannot find support for the limitation that appears in independent claims 9, 19 and 25 that the distance between the slide and step boards is greater than the combined thickness of the two boards in the originally filed disclosure. Accordingly this limitation is considered new matter and is therefore rejected under 35 USC 112 first paragraph, written description, as set forth in this Office Action.

Art Unit: 3618

Due to the new grounds of rejection, this action is made non-final. The Examiner regrets that this rejection was not set forth earlier in the prosecution of the Instant Application.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Santa Cruz, et al – teaches a snowboard with an elevated deck

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRYAN FISCHMANN
PRIMARY EXAMINER